

## **REMARKS**

This responds to the Office Action mailed on June 1, 2006. Claims 1, 3, 4, 6, 7, 9, 12, 15, 16, 18, 25, and 27-39 are currently pending in the present application, claims 38 and 39 being new. All of the pending claims that were previously presented currently stand rejected under 35 U.S.C. §102(b) and/or 35 U.S.C. § 103(a). Each of the Examiner's rejections in the numbered paragraphs of the Office Action is addressed below. In view of the following remarks, Applicant respectfully submits that the application is in complete condition for allowance and requests that the rejections be withdrawn.

### **Rejection in ¶ 2:**

The Examiner rejected claims 12, 15, 18, and 35 as being anticipated by Braun (5127204). Claim 12 recites a surround device adapted to provide a transition from a wall to a frame mounted in an opening in the wall. The device comprises several elements, including "a first leg adapted for mounting to an outer face of the wall" and "a second leg being adapted to be juxtaposed to the frame and the wall to thereby provide a transition from the frame to the wall." Claims 15, 18, and 35 depend from claim 12 and thus include the same limitations. Because Braun fails to disclose both a first and second leg, Applicants respectfully request that the rejection be withdrawn.

In particular, the Examiner's rejection states that Braun "shows a surround device comprising a first leg (10), a second leg (1a), at least one frangible joint connecting the terminal end portion (4) to a remainder of the second leg, the second leg

being more readily broken at the frangible joint than at the remainder of the second leg, the first and second legs are perpendicular to each other, the first and second legs are of dissimilar materials bonded together, terminal end portion (4) being generally coplanar with the remainder of the second leg (1d).” However, in col. 3, line 29, Braun states that the element designated by reference numeral (10) is “contact foam or insulating wool” that merely fills the lateral spacing A (Fig. 1). Such a foam or wool is not a leg “adapted for mounting to an outer surface of [a] wall,” as recited in claim 12. Nor has the Examiner indicated how the terminal end portion (4) of the second leg “is adapted to be removed along the frangible joint and thereby reveal a recess at a juncture adjacent to the frame, the wall, and the remainder of the second leg,” as further recited by claim 12. Removing the protective tab 4 in Braun merely exposes the portion of the door frame 3 over which it extends (see col. 3, lines 59-62). For all these reasons, Applicants respectfully request that the above rejection be withdrawn.

### **Rejection in ¶ 3:**

The Examiner also rejected claims 12, 15, 35, and 36 as being anticipated by Shaw (4837991)<sup>1</sup>. According to the Examiner, Shaw discloses “a surround device comprising a first leg (3), a second leg (the leg below section 9 which is next to leg 3, figure 2), at least one frangible joint connecting the terminal end portion (figure 2) to a remainder of the second leg.” The Examiner has not, however, indicated how the first

---

<sup>1</sup> Although the Examiner initially states in ¶ 3 that the claims are “anticipated by Braun (5127204),” the remainder of the paragraph refers to Shaw. Applicants have therefore presumed that the rejection is in fact based upon Shaw rather than Braun. If this understanding is incorrect, the Examiner is kindly asked to clarify the rejection.

leg of Shaw meets claim 12's recitation of "being adapted for mounting to an outer face" of a wall adjacent to an opening in the wall. The first leg in Shaw is instead adapted to define a portion of a cavity 5 beneath a concrete slab poured over the leg (see Fig. 2 and col. 4, lines 44-53).

Additionally, the second leg in Shaw is not "adapted to be juxtaposed to the frame and the wall to thereby provide a transition from the frame to the wall," as further recited by claim 12. The leg 9 is instead adapted to rest between the vertical surface of a foundation footing and a concrete slab to be poured. Thus, the leg will always automatically come into contact with the slab if sufficient concrete is poured, unlike a fixed structure such as a frame. Because Shaw does not disclose each and every limitation in claim 12, Applicants respectfully request that the rejection be withdrawn.

Claims 15, 35, and 36 depend from claim 12 and are thus patentable for at least the reasons discussed above.

**Rejection in ¶ 5:**

Claim 37 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Braun (5127204) in view of Farrell et al. (6516573). Claim 37 depends from claim 12 and further recites a frangible joint comprising "perforations in the second leg." The Examiner's rejection states: "Braun shows all of the claimed limitations except for the frangible joint comprising perforations in the second leg." As discussed above with respect to claim 12, however, Braun does not show a first leg "adapted for mounting to

an outer face of [a] wall.” Nor does Braun show the terminal end portion being removed to “reveal a recess at a juncture adjacent to the frame, the wall, and the remainder of the second leg.” Because the Examiner has not indicated how Farrell overcomes these deficiencies, Applicants respectfully request that the rejection be withdrawn. See MPEP § 2143.03 (“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.”).

Moreover, even if Braun would have shown all of the claimed limitations except for “perforations in the second leg,” Applicants submit that Farrell is non-analogous art and cannot be relied upon to overcome this deficiency. Farrell is directed to “post assemblies installed along roadways and designed to carry various types of signs or related structures” (col. 1, lines 6-8). One seeking to solve the problems associated with door and window frame installation would not consider references directed towards such post assemblies. Accordingly, Applicants request that the rejection be withdrawn.

**Rejection in ¶ 6:**

The Examiner rejected claims 1, 3, 4, 6, 7, 9, 12, 15, 18, 25-28, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Anastasi (6244001) in view of Northrup Jr. (5473851) and Shaw (4837991). In the rejection, the Examiner acknowledges that “Anastasi does not show the second wall comprising courses of masonry units held together with mortar” or “a frangible connection . . . joining the terminal end portion to a remainder of the second leg.” To overcome this deficiency,

however, the Examiner only discusses how Northrup discloses masonry units held together mortar. Nowhere in the rejection does the Examiner address how either Northrup or Shaw discloses “at least one frangible joint connecting the terminal end portion to a remainder of the second leg,” as recited in independent claims 1, 12, and 25.

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness under 35 U.S.C. § 103(b). MPEP § 2142. Because the Examiner has not indicated how the prior art references teach or suggest all the claim limitations, Applicants respectfully submit that a prima facie case of obviousness has not been established and request that the rejection be withdrawn.

**Rejection in ¶ 7:**

The Examiner rejected claims 1, 3, 4, 6, 25, 27, 28, and 31-33 under 35 U.S.C. § 103(a) as being unpatentable over Anastasi (6244001) in view of Northrup Jr. (5473851) and Shaw (4837991). Claims 1, 25, and 31 are the only independent claims in this rejection. As a preliminary matter, each of these claims recites a “frangible joint” or “frangible connection” connecting or joining “the terminal end portion to a remainder of the second leg.” The Examiner acknowledges that Anastasi does not disclose such a frangible joint or connection, but relies upon Shaw to overcome this deficiency.

Applicants respectfully submit that Shaw is non-analogous art and therefore cannot be relied upon to support a § 103(a) rejection. “In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either

be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992); MPEP § 2141.01(a).

Claim 1 of Applicants' invention is directed to a surround device for door and window installations, while claims 25 and 31 are directed to a cavity wall construction incorporating a type of such a surround device. As described on page 2 of the present application, in lines 11-20, the window or door frame installed in a wall is often different than and incompatible with the geometry and dimensions of the associated wall cavity. The surround device and wall constructions recited in claims 1, 25, and 31 are designed to alleviate the frustrations associated with these problems by providing a proper transition between the window or door frame and the wall cavity. Thus, the field of endeavor is door and window installation, and the problem addressed is providing a proper transition between the components.

Shaw, on the other hand, discloses a structure to provide drainage at the juncture between a foundation wall and its footing. *See, e.g.*, col. 2, lines 49-59. The fact that the structures in Shaw and the present application merely relate to the construction industry does not alone make them within the same field of endeavor. *See In re Clay*, 966 F.2d 656, 659, 23 U.S.P.Q.2d 1058 (Fed. Cir. 1992) (inventions not considered within same field of endeavor "merely because both relate to the petroleum industry"). Rather, the field of endeavor of Shaw's invention is the pouring of foundation walls and the problem addressed is drainage. One trying to solve the problems associated with door and window installation in masonry veneer and wall cavities would

not logically consider references dealing the pouring of concrete foundations and the problem of drainage.

Notwithstanding the issue of non-analogous art, Applicants respectfully submit that additional grounds support the withdrawal of the Examiner's rejection. In particular, claim 25 as amended recites a second leg being "juxtaposed against the frame and the second wall." Being juxtaposed against both of these components helps provide a solid support for a backer rod and caulk 78 or other filling material used to fill the recess 76 after the terminal end portion 68 is removed (see Figs. 5A and 6 of the application). Claims 38 and 39 have been added to clarify this aspect of the invention recited in claims 1 and 31, respectively. Applicants submit that the Examiner's rejection should be withdrawn because none of the references cited by the Examiner disclose a second leg being juxtaposed in such a manner.

In particular, Anastasi discloses a flashing comprising a first panel 12, second panel 14, and third panel 16. The Examiner cited the third panel 16 as representing the second leg recited in the rejected claims of the present application. Although the panel 16 may be adapted to engage a side surface 96 of the window frame 90 (see Fig. 3), the panel 16 is not juxtaposed against both the frame 90 and the wall 68. As such, when a sealant system or backer rod 85 is inserted into the space between the panel 16 and wall structure 68 there is no support provided by the Anastasi device. Applicants' device as recited in the amended claims fills the lateral void between the frame and the wall and provides structure against which a backer rod and sealant can be installed. Combining Shaw and Northrup with Anastasi does not provide

this feature because neither secondary reference teaches the second leg of a surround device or flashing being juxtaposed to both a frame and wall.

In summary, because Shaw is non-analogous prior art and cannot be relied upon to support an obviousness rejection, Applicants respectfully request that the rejection be withdrawn. Furthermore, Applicants request that the rejection be withdrawn because none of the references cited by the Examiner disclose a second leg being juxtaposed to the frame and the wall.

**Rejection in ¶ 8:**

The Examiner rejected claims 7, 9, 16, 18, 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Anastasi (6244001) in view of Northrup Jr. (5473851), Shaw (4837991), Trout (6993874), and Farrell et al. (6516573). As a preliminary matter, each of these claims (or the claims from which they depend) recites a “frangible joint” or “frangible connection” connecting or joining “the terminal end portion to a remainder of the second leg.” As with the rejections in ¶ 6 and ¶ 7, the Examiner acknowledges that Anastasi fails to disclose such a structure and relies upon Shaw to overcome this deficiency. Because Shaw is non-analogous prior art (as discussed above), Applicants respectfully request that the rejection be withdrawn.

Furthermore, independent claims 7, 16, 29 all recite a second leg of a device being juxtaposed to a frame and a wall. As discussed above with reference to the rejection in ¶ 7, Anastasi does not disclose a second leg being juxtaposed in such a manner. The additional references cited by the Examiner (Trout and Farrell) fail to

overcome this deficiency. Because the other rejected claims depend from claims 7, 16, and 29, Applicants respectfully request that the rejection be withdrawn.

**Rejection in ¶ 9:**

The Examiner rejected claim 34 “under 35 U.S.C. § 103(a) as being unpatentable over Anastasi (6244001) in view of Northrup Jr. (5473851) and Shaw (4837991) as applied to claim 1 above and further in view of Farrell et al. (6516573).” By “as applied to claim 1 above,” Applicants are assuming the Examiner was referring the rejection of Claim in ¶ 6 or ¶ 7 of the Office Action. The arguments Applicants have made with respect to those rejections apply equally to the rejection of claim 34, which depends from claim 1 and thus includes all of the same limitations. Additionally, even if the rejection of claim 1 is not withdrawn, Applicants respectfully submit that Farrell is non-analogous prior art as discussed above and cannot be relied upon to support a § 103 rejection. For all of these reasons, Applicants request that the rejection of claim 34 be withdrawn.

**CONCLUSION**

Applicants respectfully submit that the foregoing is a full and complete response to the Office Action mailed on June 1, 2006. Applicants also respectfully submit that the pending claims are patentable for the reasons discussed above. If the Examiner believes any matter requires further discussion, the Examiner is invited to telephone the undersigned attorney so that the matter may be promptly resolved.

Applicants believe that no fees are due in connection with this response.

If such petition is due or any fees are necessary, however, the Commissioner may consider this to be a request for such and charge any necessary fees to deposit account 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

/Keith R. Haupt/  
Keith R. Haupt  
Reg. No. 37,638

2700 Carew Tower  
441 Vine Street  
Cincinnati, OH 45202  
(513) 241-2324 (voice)  
(513) 421-7269 (facsimile)  
[khaupt@whepatent.com](mailto:khaupt@whepatent.com)  
K:\mik\06\supplemental amendment.doc